

## REMARKS

In the Office Action dated February 13, 2004, the Examiner rejected claims 1-63 under 35 U.S.C. § 103(a). Claim 18 has been amended for antecedent basis purposes. Applicant believes that none of the five references cited by the Examiner show or suggest either (1) providing a reading recommendation of books to read based on an evaluating means or (2) adjusting a level profile of an electronic book. Accordingly, Applicant respectfully traverses the claim rejections and requests reconsideration.

### **A. Response to the Adams/Parry 35 U.S.C. § 103(a) Rejections**

Claims 1, 2, 4, 5, 42-44, and 49 were rejected under 35 U.S.C. § 103(a) as being obvious in light of the combination of U.S. Patent No. 6,017,219 ("Adams") and U.S. Patent 6,077,085 ("Parry"). Applicant respectfully traverses these rejections.

In claim 1, Applicant recites an automatic reading system that includes a means for detecting speech of a user who is reading out loud, a means for evaluating the user's reading skill, and a means for making recommendations of books to read based on the evaluating means. Similarly, in claim 42, Applicant recites an automatic reading system that includes a client device and a server device. The server device is operable to detect speech from a user reading from a book, evaluate the speech, and provide recommendations of books to read to the user. Thus, the automatic reading system can be used to provide a list of books that would be appropriate for the user's reading level when, for example, a teacher or librarian is unavailable. (See, e.g., Applicant's Specification, page 3, lines 18-21.)

The Office Action states that Adams does not specifically disclose that the recommendations

are for books based on the evaluating means. (See Office Action, pages 2-3.) Applicant believes that Parry does not overcome this deficiency in Adams. Parry describes an integrated instructional system that includes print materials, practice activities, and computer activities. (See, Parry, column 2, lines 35-38.) Parry describes that the content for each subject to be learned is stored in a database. (See, Parry, column 6, lines 22-24.) This content can then be used to generate the print materials. (See, Parry, column 6, lines 26-28.) However, it is the users of the system and not the system itself, which make the print materials. (See, Parry, column 22, lines 49-51.)

The user has the ability to create customized study materials from the elements in the present invention's databases. Students can create textual study materials that can be imported into a word processor for manipulation and exercise or print directly from the program to create memorization lists or other materials. (See, Parry, column 22, lines 52-57.)

Thus, the print materials are created by a user and not recommended by the instructional system. Because the print material not recommended, it follows that the print material is not recommended based on an evaluating means. Accordingly, Applicant believes that Parry does not disclose that the recommendations are for books based on the evaluating means.

Because neither Adams nor Parry show or suggest making a recommendation of books to read based on the evaluating means, the combination of Adams and Parry does not show or suggest each and every element of claims 1 and 42. Accordingly, Applicant submits that claims 1 and 42 are not obvious in light of the combination of Adams and Parry.

Claims 2, 4, and 5 depend from claim 1. Claims 43, 44, and 49 depend from claim 42. Accordingly, Applicant also submits that claims 2, 4, 5, 43, 44, and 49 are not obvious in light of the combination of Adams and Parry for at least the reasons set forth above.

## **B. Response to the Adams/Waters 35 U.S.C. § 103(a) Rejections**

Claims 8-15, 17, 19, 21-29, 34-36, 38-39, and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of U.S. Patent No. 5,540,589 (“Waters”). In claim 8, Applicant recites an automatic reading system that includes an evaluation device operable to convert an estimate of speech into a score and a recommendation device operable to use the score to provide a recommendation of books to read. Similarly, in claim 34, Applicant recites a method of providing an automatic reading system that includes estimating linguistic content, converting the estimate into a score, and providing a recommendation of books to read based on the score.

The Office Action states that Adams does not specifically disclose converting the estimate of speech into an item score or using the score to provide a reading recommendation. (See Office Action, page 5.) Claims 8 and 34 also include the element that the recommendation is a recommendation of books to read, which Applicant believes is also not disclosed in Adams. Further, Applicant believes that Waters does not overcome these deficiencies in Adams.

The Office Action cites to the background section of Waters for the proposition of converting an estimate of speech into an item score. (See Office Action, page 5.) However, Waters does not suggest making a recommendation of books to read based on the score. In fact, Waters describes an interactive tutor that is “all-audio, hands-free and eyes-free.” (See, Waters, Abstract.) As the interactive tutor is hands-free and eyes-free, Waters teaches away from the use of an automatic reading system. Accordingly, Applicant believes that Waters does not disclose using a score to provide a recommendation of books to read. Because the combination of Adams and Waters does not show or suggest each and every element of claims 8 and 34, Applicant submits that claims 8 and 34 are not obvious in light of the combination of Adams and Waters.

Claims 9-15, 17, 19, and 21-29 depend from claim 8. Claims 35, 36, 38, 39, and 41 depend from claim 34. Accordingly, Applicant also submits that claims 9-15, 17, 19, 21-29, 35, 36, 38, 39, and 41 are not obvious in light of the combination of Adams and Waters for at least the reasons set forth above.

### **C. Response to the Adams/Huffman 35 U.S.C. § 103(a) Rejections**

Claims 3 and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of U.S. Patent No. 5,697,793 ("Huffman"). Claim 3 depends from claim 1. Claim 48 depends from claim 42. As described above, Adams does not show or suggest making a recommendation of books to read based on the evaluating means. Applicant believes that Huffman fails to overcome this deficiency in Adams.

Huffman describes displaying at least one reading metric on an electronic book. (See, e.g., Huffman, Abstract.) The at least one reading metric may be a reading pace, the amount of book that can be read at the reading pace during the remaining power time, or an estimated completion time for a portion of the book. (See, e.g., Huffman, Abstract.) The metrics are based on the electronic book currently being read by the user. To provide a reading metric for the electronic book currently being read, it is unnecessary to provide a recommendation of a different book to read. Accordingly, Applicant believes that Huffman does not show or suggest making a recommendation of books to read. Because, Huffman does not show or suggest making a recommendation of books to read, it follows that Huffman does not disclose making a recommendation of books to read based on an evaluation means. Because the combination of Adams and Huffman does not show or suggest each and every element of claims 3 and 48, Applicant submits that claims 3 and 48 are not obvious in light of the combination of Adams and Huffman.

#### **D. Response to the Adams/Waters/Huffman 35 U.S.C. § 103(a) Rejection**

Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Waters in further view of Huffman. Claim 18 depends from claim 8. As described above, Adams, Waters, and Huffman do not show or suggest making a recommendation of books to read based on an evaluating means. Accordingly, Applicant submits that claim 18 is not obvious in light of the combination of Adams, Waters, and Huffman for at least the reasons set forth above.

#### **E. Response to the Adams/Wasowicz 35 U.S.C. § 103(a) Rejections**

Claims 6-7, 30, 32-33, 45-47, and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of U.S. Patent No. 6,299,452 ("Wasowicz"). In claim 30, Applicant recites an automatic reading system that includes an evaluation device operable to convert an estimate of speech into an item score and a recommendation device operable to use the item score to provide a recommendation of books to read. As described above, Adams does not show or suggest making a recommendation of books to read based on an evaluation means. Applicant believes that Wasowicz fails to overcome this deficiency in Adams.

Wasowicz shows using graphical games to test a user's phonological awareness, phonological processing, and reading skills. (See, e.g., Wasowicz, Abstract). The system shown by Wasowicz may suggest training modules that train a particular phonological awareness, phonological processing skill, or a related reading skill. (See, e.g., Wasowicz, column 3, lines 50-54.) For example, scores may indicate that the child has weak/below average rhyme recognizing skills and a recommender may recommend that the child play the rhyme recognizer training tool in order to boost the child's rhyme recognition abilities. (See Wasowicz, column 7, lines 54-58.) While Wasowicz

recommends training modules to perform, Wasowicz does not show or suggest making a recommendation of books to read based on the scores. Because the combination of Adams and Wasowicz does not show or suggest each and every element of claim 30, Applicant submits claim 30 is not obvious in light of the combination of Adams and Wasowicz.

Claims 6-7 depend from claim 1. Claims 32-33, 45-47, and 50 depend from claim 30. Accordingly, Applicant also submits that claims 6, 7, 32-33, 45-47, and 50 are not obvious in light of the combination of Adams and Wasowicz for at least the reasons set forth above.

#### **F. Response to the Adams/Wasowicz/Parry 35 U.S.C. § 103(a) Rejections**

Claims 30, 32, and 33 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Wasowicz and in further view of Parry. As described above, Adams, Wasowicz, and Parry do not show or suggest making a recommendation of books to read based on an evaluation means. Accordingly, Applicant submits that claims 30, 32, and 33 are not obvious in light of the combination of Adams, Wasowicz, and Parry for at least the reasons set forth above.

#### **G. Response to the Adams/Waters/Wasowicz 35 U.S.C. § 103(a) Rejections**

Claims 16, 20, 37, and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Waters in further view of Wasowicz. Claims 16 and 20 depend from claim 8. Claims 37 and 40 depend from claim 34. As described above, Adams, Waters, and Wasowicz do not show or suggest making a recommendation of books to read based on an evaluation means. Accordingly, Applicant submits that claims 16, 20, 37, and 40 are not obvious in light of the combination of Adams, Waters, and Wasowicz for at least the reasons set forth above.

## **H. Response to the Adams/Wasowicz/Parry/Huffman 35 U.S.C. § 103(a) Rejection**

Claim 31 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Wasowicz in further view of Parry in further view of Huffman. Claim 31 depends from claim 30. As described above, Adams, Wasowicz, Parry, and Huffman do not show or suggest making a recommendation of books to read based on an evaluation means. Accordingly, Applicant submits that claim 31 is not obvious in light of the combination of Adams, Wasowicz, Parry, and Huffman for at least the reasons set forth above.

## **I. Response to the Parry/Huffman 35 U.S.C. § 103(a) Rejections**

Claims 51, 52, 62, and 63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parry in view of Huffman. In claim 51, Applicant recites an automatic reading system that includes a recommendation module that recommends electronic books based upon a user's reading level. As described above, neither Parry nor Huffman shows or suggests making a recommendation of books to read based on an evaluating means. Accordingly, Applicant submits that claim 51 is not obvious in light of the combination of Parry and Huffman.

In claims 52, 62, and 63, Applicant recites an automatic reading system that includes a means for adjusting a level profile of an electronic book. The level profile of a book may indicate the reading level of the book, which may allow teachers and others to choose books appropriate to the reading skills of a student. (See, e.g., Applicant's Specification, page 2, lines 16-20.) The level profile of the electronic book may be decreased if the user is struggling with the text of the electronic book or increased if the user is reading easily from the electronic book. (See, e.g., Applicant's Specification, page 15, lines 16-21.) Accordingly, the text of the electronic book changes as the level profile of the electronic book changes.

Parry is silent with respect to the use of electronic books. While Huffman discusses an electronic book, Huffman does not describe adjusting the text of the electronic book in any manner. Huffman determines a reading metric, such as reading pace, the amount of book that can be read at the reading pace during the remaining power time, or an estimated completion time for a portion of the book, and displays the metric without making any changes to the text of the electronic book itself. Accordingly, Applicant believes that Huffman does not describe adjusting the level profile of an electronic book. Because the combination of Parry and Huffman does not show or suggest each and every element of claims 52, 62, and 63, Applicant submits that claims 52, 62, and 63 are not obvious in light of the combination of Parry and Huffman.

#### **J. Response to the Parry/Huffman/Waters 35 U.S.C. § 103(a) Rejections**

Claims 53-61 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parry in view of Huffman and in further view of Waters. In claim 53, Applicant recites an automatic reading system. The automatic reading system includes a speech recognition system operable to provide an estimate of speech and an evaluation device operable to convert the estimate of speech into a score. The system further includes a recommendation device operable to use the score to adjust a level profile of an electronic book.

Parry and Waters are silent with respect to the use of electronic books. As described above, Huffman does not show or suggest adjusting the level profile of an electronic book. Because the combination of Parry, Huffman, and Waters does not show or suggest each and every element of claim 53, Applicant submits that claim 53 is not obvious in light of the combination of Parry, Huffman, and Waters.

Claims 54-61 depend from claim 53. Accordingly, Applicant also submits that claims 54-61



are not obvious in light of the combination of Parry, Huffman, and Waters for at least the reasons set forth above.

In light of the above, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 103(a).

### **CONCLUSION**

In light of the above amendments and remarks, Applicant submits that the present application is in condition for allowance and respectfully request notice to this effect. The Examiner is requested to contact Applicant's representative below if any questions arise or she may be of assistance to the Examiner.

Respectfully submitted,



Lisa M. Schoedel  
Reg. No. 53,564  
McDonnell Boehnen Hulbert & Berghoff LLP  
300 South Wacker Drive  
Chicago, Illinois 60606-6709  
312 935 2362  
schoedel@mbhb.com

Dated: April 13, 2004